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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/520,701 | 01/06/2005 | Hidetaka Oka | EL/2-22711/A/CGJ 128/PCT | 2587 |
| 324 | 7590 | 04/20/2006 | EXAMINER | |
| CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005 | | | LETSCHER, GERALDINE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1752 | |

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--|-----------------------------------|--|
| Office Action Summary | Application No. 10/520,701 | Applicant(s) OKA ET AL. | |
| | Examiner Geraldine V. Letscher | Art Unit 1752 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005 and 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3-21-05</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected as being vague and indefinite when it recites "(a) to (e) being 100% by weight" at the ultimate line; the scope of the protection sought is not clear.

Claim 1 fails to particularly point out and distinctly claim that the total of the wt% of (a) to (e) is 100% by weight.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elzer et al. (U.S. Patent No. 4,725,524) in view of either Burri (U.S. Patent No. 4,154,463) or Iwasaki et al. (U.S. Patent No. 4,598,036).

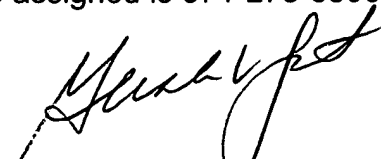
Elzer et al. discloses a process for preparing a dry film resist, which process comprises forming a photocurable resin composition onto a support film with a thickness of 1 to 50 μ m and optionally laminate a protective film onto the photocurable composition

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layer to obtain a dry film resist; whereby the photocurable resin is formed from a homogeneous mixture comprising (a) from 20-90 wt % of an alkaline soluble binder oligomer or polymer; (b) from 5 to 60 wt % of one or more photopolymerizable monomers which are compatible with the oligomers and polymers of component (a); (c) from 0.01 to 20% by weight of one or more photoinitiators; and (d) from 0 to 20% by weight of additives and/or assistants, wherein the total of the wt% of (a) to (d) is 100% by weight. Although Elzer et al. does not disclose the leuco triphenylmethane dye of the instant formula I, the use of the leuco triphenylmethane dye of the instant formula I as a color former in film resists as well known in the art, as illustrated in each of Burri and Iwasaki et al. It would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to incorporate a leuco triphenylmethane dye of the instant formula I into the dry film resist of Elzer et al. as component (d) therein, with reasonable expectations of achieving, absent object evidence to the contrary, the advantages taught therein as well as those associated with the use of the leuco triphenylmethane compound.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldine V. Letscher whose telephone number is (571) 272-1334. The examiner can normally be reached 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



GERALDINE LETSCHER
PRIMARY EXAMINER
GROUP 1100

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).